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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,942	07/26/2001	Daniel C. Castle	10003069-1	8801

7590 10/18/2006
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER LASTRA, DANIEL	
ART UNIT 3622	PAPER NUMBER

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,942

Applicant(s)

CASTLE, DANIEL C.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-16 have been examined. Application 09/916,942 (Method and apparatus for increasing on-line publication distribution) has a filing date 07/26/2001.

Response to Amendment

2. In response to Final Rejection filed 05/02/2006, the Applicant filed an RCE on 08/02/2006, which amended claims 1, 7-9, 15 and 16.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard (US 2005/0091109) in view of Blaser (US 6,757,661).

As per claims 1, 7 and 8, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see Howard paragraph 8);

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automatically tracking publication distribution to various receipt subscribers (see Howard paragraph 26);

determining the subscriber's publication usage levels from data in said user profile (see Howard paragraph 46);

sending the subscriber a targeted paid advertisement (see Howard paragraphs 50-51);

sending the subscriber a targeted content advertisement for the publication for the publication in which said targeted content advertisement is placed (see Howard paragraph 59), said targeted content advertisement being selected based upon at least one of:

data in said user profile (see Howard paragraph 59); and

advertising space available in said publication for content advertising usage (see Howard paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59);

detecting the subscriber's request for continued delivery of said specified content via said data network (see Howard paragraph 39) ;

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see Howard paragraph 40).

Howard does not expressly teach that if the subscriber's usage level is determined to be above a first predetermined level ("high") sending the subscriber a targeted paid advertisement and if the subscriber's usage level is determined to be

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below a second predetermined threshold ("low") sending the subscriber a targeted content advertisement. However, Official Notice is taken that it is old and well known in the promotion art to try to persuade consumers that are already high level users of a product to buy additional related product at a discount (*i.e.* "upsell") by targeting said consumers with alternative advertisements or offers of said related products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Howard would determine a consumer's electronic publication usage level from the consumer's profile (see Howard paragraph 40) and would target said consumer with alternative "paid advertisements" if said usage level of said consumer is high as it is old and well known to try to persuade consumers to buy additional related products at a discount when said consumers usage level of a product is already high.

Howard fails to teach *recording times during the day that the subscriber requests files of the publications, the recorded times, the files that the subscriber requested, whether the subscriber requested a download of particular known type of file*. However, Blaser teaches a system that targets advertisements based upon user's profile and usage history, where said usage history comprises the type of network data said user requests and accesses and the time of day where said requests occurs (see Blaser col 6, lines 40-55; col 9, line 55 – col 10, line 39). Therefore, electronic publishers would be motivated to send new subscriptions' offers to consumers based upon the profile data items in the consumer profiles (see Howard paragraph 59) and usage history, as taught by Blaser in order to target renewal or new publications' subscriptions advertisements to

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consumers that would have, due to a consumers' low usage level, the time and inclination to subscribe to new publications, therefore, increasing the profit of said publishers by increasing the number of subscribers to said publishers' publications. And electronic publishers would be motivated to send products' advertisements, instead of new subscriptions' publications advertisements (see Howard paragraph 56), to consumers with a high electronic publication usage level in order to allow said publishers to generate profits from consumers that, due to their high usage level, would not subscribe to said publishers' publications but would view said publishers' products advertisements, therefore, allowing said publishers to bill advertisers for said viewing.

As per claim 2, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of: data in said user profile; and advertising space available in said publication for content advertising usage (see paragraph 8).

As per claim 3, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of: data in said user profile; and advertising space available in said publication for content advertising usage (see paragraphs 8 and 59);
and

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including in said content advertisement, a sample of the specified content and instructions as to how to continue to receive said specified content via said publication (see paragraph 46).

As per claim 4, Howard teaches:

The method of claim 1 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user based upon said user profile and the advertising space available for content advertising usage (see paragraphs 8 and 59);

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraphs 57-59);

assembling said content advertisement and said sample of the specified content into a data package and transmitting the data package to the subscriber via said data network (see paragraphs 57-59).

As per claim 5, Howard teaches:

The method of claim 1 further comprised of the steps of:

detecting via said data network, the subscriber's request for continued delivery of said specified content via said data network (see paragraph 56);

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 56).

As per claim 6, Howard teaches:

The method of claim 1 further comprised of the steps of:

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detecting via said data network, the subscriber's request for continued delivery of said specified content via said data network (see paragraph 56);

modifying data in the user profile to reflect the subscriber's request for continued delivery of said specified content (see paragraph 56);

monitoring the subscriber's usage levels of said publication (see paragraph 56).

As per claims 9, 15 and 16, Howard teaches:

In an on-line publication ("publication") distributed to a plurality of publication subscribers via a data network, a method of sending to a publication subscriber, at least one of either: paid advertising messages or content advertising messages;

said method comprising the steps of:

reading from a server for said publication, a user profile for the subscriber (see Howard paragraph 8);

automatically tracking publication distribution to various recipient subscribers (see Howard paragraph 26);

determining the subscriber's publication preferences from data in said user profile (see Howard paragraph 42);

sending the subscriber a targeted paid advertisement consistent with the subscriber's determined preferences (see Howard paragraphs 50-51);

sending the subscriber a targeted content advertisement consistent with the subscriber's determined preferences (see Howard paragraph 59).

However, Official Notice is taken that it is old and well known in the promotion art to try to persuade consumers that are already high level users of a product to buy

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additional related product at a discount (i.e. "upsell") by targeting said consumers with alternative advertisements or offers of said related products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Howard would determine a consumer's electronic publication usage level from the consumer's profile (see Howard paragraph 40) and would target said consumer with alternative "paid advertisements" if said usage level of said consumer is high as it is old and well known to try to persuade consumers to buy additional related products at a discount when said consumers usage level of a product is already high.

Howard fails to teach *recording times during the day that the subscriber requests files of the publications, the recorded times, the files that the subscriber requested, whether the subscriber requested a download of particular known type of file*. However, the same argument made in claim 8 regarding said missing limitation is also made in claim 9.

As per claim 10, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52).

As per claim 11, Howard teaches:

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The method of claim 9 wherein said step of sending a targeted content advertisement is further comprised of the step of:

selecting a content advertisement for transmission to the user, the selection of which is based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available in said publication for content advertising usage (see paragraph 52); and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59).

As per claim 12, Howard teaches:

The method of claim 9 wherein said step of sending a targeted content advertisement is comprised of the step of:

selecting a content advertisement for transmission to the user based upon at least one of:

data in said user profile (see paragraph 59); and

advertising space available for content advertising usage (see paragraph 59);
and

including in said content advertisement a sample of the specified content and instructions as to how to receive said content (see paragraph 59);

assembling said content advertisement and said sample of the specified content into a data package and transmitting the data package to the subscriber (see paragraph 44).

As per claim 13, Howard teaches:

The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content
(see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued
delivery of said specified content (see paragraph 40).

As per claim 14, Howard teaches:

The method of claim 9 further comprised of the steps of:

detecting the subscriber's request for continued delivery of said specified content
(see paragraph 39);

modifying data in the user profile to reflect the subscriber's request for continued
delivery of said specified content (see paragraph 39);

monitoring the subscriber's usage levels (see paragraphs 36, 46).

Response to Arguments

4. Applicant's arguments filed 08/02/2006 have been fully considered but they are not persuasive. The Applicant argues that none of the recited references teach "including recording times during the day that the subscriber requests files of the publications, the recorded times, the files that the subscriber requested, whether the subscriber requested a download of particular known type of file". The Examiner answers that Blaser teaches a system that targets advertisements based upon user's profile and usage history, where said usage history comprises the type of network data said user requests and accesses and the time of day where said requests occurs (see

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Blaser col 6, lines 40-55; col 9, line 55 – col 10, line 39). Therefore, contrary to Applicant's argument, Blaser teaches Applicant's newly added features.

The Applicant further argues that the Examiner is using improper hindsight in combining the reference. The Examiner answers that conclusion of obviousness are, by their nature, based upon some hindsight reasoning and it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. However, so long as the reasoning takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Howard teaches targeting consumers with paid advertisements¹ and/or with "electronic publication offers" (*i.e.* content advertisements)², where said targeting is based upon said consumers' electronic publication usage level profile (*i.e.* viewing and/or electronic publication subscriptions)³. Blaser teaches that it is old and well known determining a consumers' usage level profile based upon type of network data said consumers requests and accesses and the time of day where said requests occurs⁴. Therefore, contrary to Applicant's argument, there is no improper hindsight to conclude that it would have been obvious to a person of ordinary skill in the art, at the time the application was made, to know that Howard would target consumers already receiving a lot of electronic publications (*i.e.* "high level subscription level") with

¹ Howard paragraphs 50,51

² Howard paragraph 59

³ Howard paragraphs 56-59

⁴ Blaser col 6, lines 40-55; col 9, line 55 – col 10, line 39

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"paid ads" instead of "content ads" (i.e. offers to electronic publications subscriptions) in order that advertisers do not waste their time and money targeting consumers with additional electronic publication publications offers⁵ (i.e. "content ads") that said consumers would not respond to, due to the said consumers high level subscription level.

Conclusion

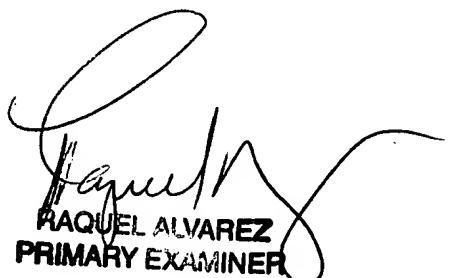
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel Lastra
October 7, 2006

⁵ Howard paragraph 56


RAQUEL ALVAREZ
PRIMARY EXAMINER